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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,414	04/05/2001	Hans Josef Rinninger	31530-171041	5027

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EXAMINER

ADDIE, RAYMOND W

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/826,414

Applicant(s)

RINNINGER, HANS JOSEF

Examiner

Raymond W. Addie

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 12, 13 is rejected under 35 U.S.C. 112, first paragraph, as containing

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, lines 3-4 recite "the perpendicular distances between the planar portions of the opposite faces of said molded block being substantially equal" is not disclosed in the specification.

Further, it is unclear as to how opposite faces of a cube can have a perpendicular distance between them. It is believed that opposite faces of a cube have a "straight line" distance between them, and that adjacent sides of a cube can have a perpendicular angle between said sides, but it is unclear as to how a "perpendicular distance" would be measured between opposite sides of a cube. Hence, it is indefinite as to what limitation is being claimed, and what if any equivalent structures would be within the scope of the claimed limitation.

For examination purposes the phrase "perpendicular distance between the planar portions of opposite faces, is being interpreted as the "perpendicular distance between adjacent faces of the approximately cube shaped paving stone.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 6, 8, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheiwiller # 5,533,827.

Scheiwiller discloses a paving stone (1) molded from concrete for use in a ground covering. Said paving stone comprising:

A cubical shape (see col. 3, line 28), with planar or tapered side faces (16, 9), and upper and lower faces (10, unnumbered). Each face of said molded block having at least a portion that is planar. A perpendicular distance between the planar portions of the adjacent faces of said molded block being substantially equal. At least a 1st one of said faces of said molded block being substantially planar over substantially its entire surface area, by keeping the polygon faces (17) to a minimal value, i.e. the gap between the stones can be kept very small.

At least a 2nd one of said faces having at least one rounded portion extending toward one side edge of said molded block over at least 1/6 of said at least one face.

Although Scheiwiller does not explicitly recite at a 1st being substantially planar over substantially its entire surface area, it is clearly obvious from Figs. 1a-1e that top face (10) is substantially planar over most of the surface area, except for clothodially rounded edges (11), as well as the specific recitation in col. 6, that polygonal paces (17) are intended to be kept to a minimal value. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the paving stone of Scheiwiller with at least one face that is substantially planar over substantially its entire surface, as reasonably suggested by Scheiwiller, in order to provide at least one surface adapted to be contacted by pedestrians and/or vehicles.

See col. 6, Ins 8-11; Col. 3, ln. 28; Col. 4, Ins. 6-30; Col. 5, Ins 25-64.

In regards to Claims 5, 6, 8, 11, 12 Scheiwiller discloses the rounded portion of the paving stones can be uniformly rounded or rounded at an increasing or decreasing rate, such as a clothodial curve. See col. 5, lines 55-64.

3. Claims 2, 7, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheiwiller '827 in view of McClintock # 957,985.

Scheiwiller discloses the use of cuboidal stones in a variety of patterns, but does not disclose using each face of said block as an upper face.

However, McClintock teaches a cuboidal-paving block (C) that has 6 identical sides, all of which could be used as an upper face and at least one sharp edge. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the paving stone of Scheiwiller, in a manner such that any of the sides of the block could be used as top paving surface, as taught by McClintock, in order to reduce produce a variety of differently patterned walkways, driveways, roadways using said blocks. See Scheiwiller Col. 1, Ins. 46-62; McClintock col. 1-col. 2; Fig. 4.

4. Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheiwiller '827 in view of Scheiwiller # 4,627,764.

Scheiwiller discloses essentially all that is claimed, to include the block cited in Claim 1. Scheiwiller further discloses the blocks can form oblong blocks with planar sides (16), that obviously can be used as a horizontal upper face during laying of said stones. See fig. 1b, 1c. What Scheiwiller '827 does not disclose is an oblong block having twice the length of the original cuboidal block. However, Scheiwiller '764 teaches it is desirable to use a plurality of different sized paving blocks (5, 10) in a set together. Said 2nd block (10) being illustrated in Fig. 6, as being twice the length of the original block (5), or any other length with respect to block (5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the molded block set of Scheiwiller '827 with a second set of blocks having twice the

length of said blocks of said 1st set, as taught by Scheiwiller '764, in order to maximize the different patterns that can be formed by the sets of blocks. See Scheiwiller '827 col. 3, lines 28-35, col. 4, lines 6-10; Scheiwiller '764 col. 2.

With respect to Claim 4, Scheiwiller '827 discloses essentially all that is claimed, except for the specific recitation that a second set of molded blocks contains a one-piece block which is square in plan view and with dimensions of four cubes with the size of said 1st mentioned cube lying beside one another. However, Scheiwiller '764 clearly teaches "it is clear that the stone may have any other shape, e.g. the configuration of a sector, such as stone 10 in fig. 10 for permitting the stone to be laid down into a circle or to produce stones with greater or shorter lengths".

Response to Arguments

6. Applicant's arguments filed 4/7/2003 have been fully considered but they are not persuasive.

The Applicant repeated the arguments set forth in the interview of 3/3/2003 with respect to the prior art reference (Scheiwiller '827) teaching that the paving stones are cuboidal, does not read on the language of Claim 1, requiring the paving stone to be "approximately the shape of a cube" see claim 1, ln. 2.

The Examiner does not concur because the issue is one of relative degree.

Further Scheiwiller '826 clearly discloses "the paving stone construction set is built up in a basic grid dimension of the length $a = 12.5$ cm...The cross-sectionally square 1/1 stone with the side length a , represented in Figs. 1a and 2a, serves as the basic stone".

It is not seen that a patentable distinction can be made between the claimed limitation that the paving stone be "approximately the shape of a cube" and the prior art teaching of a cuboidal paving stone, as set forth in Col. 3, ln. 28 of the Scheiwiller patent.

Further, Merriam Webster's Collegiate Dictionary, 10th Edition 1997 further defines "cuboid" as 1: "approximately cubical in shape 2: relating to or being the cuboid".

Hence, it is not seen the "approximately the shape of a cube" is patentably distinct from the prior art teaching of a "cuboidal paving stone".

The Applicant furthers the argument by stating "Claim 1 as amended, requires one of the faces of the molded block to be substantially planar over substantially its entire surface area".

To that affect, Scheiwiller clearly discloses planar side faces (16, 31) as well as planar top face (10).

The Applicant further argues "one of the faces of the molded block to have a curved portion extending towards one side edge of the molded block over at least 1/6th of the face of the molded block".

To that affect Scheiwiller discloses providing clothodially curved sections (11) extending between the top face (10) and the side faces (16, 31).

The Applicant argues "the perpendicular distances between the planar portions of the opposite side faces are equal".

However, the suggested phrase is not consistent with the actual language of Claim 1.

Claim 1 does not recite "opposite side faces are equal" as argued.

Further, the specification does not support the claimed limitation.

Therefore, the argument is moot.

The Applicant further argues "this concept of the paving stone with the differently shaped faces in the form of a cube wherein the distances between the opposite faces and profiles facing upwardly is not suggested in any of the prior art".

However, it is unclear how a paving stone in the shape of a cube, as argued, could have differently shaped faces, and still be considered a cube.

Further, it is unclear as to how one would patentably distinguish between the claimed, "approximately the shape of a cube" and having differently shaped faces; and the prior art teaching of a cuboidal paving stone.

Hence the argument is not persuasive.

The Applicant argues "The fact that McClintock has a block with identical six sides does not suggest or make it obvious to use the paving stone in Scheiwiller which has differently shaped faces as the top paving surface... More importantly, there is nothing in either McClintock or Scheiwiller to suggest to a person with ordinary skill in the art to modify the molded block in Scheiwiller to be in a form so that each of the faces of the Scheiwiller patent can be used as a horizontal upper face during laying as recited in claim 2... Nor can any reason be found in either Scheiwiller or McClintock to make one edge to be sharp edged as recited in Claim 7".

However, Scheiwiller discloses the side edges (12) are designed to be rounded off. See col. 3, Ins. 61, 62. The "designed to" phrase reasonably suggests a preferred embodiment and cannot be used limit the scope of the patented invention.

Further Scheiwiller '829 clearly states the paving stone is in the form of a cuboid and the dimensions of the polygonal faces (17) can be minimized to a minimal value; which reasonably suggests that regardless which of the six sides of the cuboid are disposed "face up"; the overall height of the stone would remain constant. Further, Scheiwiller clearly discloses the paving stones can be used to form a variety of patterns with or without additional paving stones of various sizes and shapes.

Reference to McClintock was made to show the obviousness in using a cuboidal paving stone having at least one sharp edge and six identical sides, such that any of the six sides can be used as an upper face.

Specifically, McClintock teaches the cuboidal paving stones can be "dumped from the conveying cart and spread out with ordinary stone forks or potato hooks... The form of the cubes insures that they will always rest upon their bases. Hence it would be obvious that by using cuboidal paving stones, the stones do not have to be placed in a specific orientation, which would result in a savings of time and labor.

The Applicant argues against the combination of Scheiwiller '827 in view of Scheiwiller '764 by stating "none of the sides other than the top surface (10) and presumably the bottom surface of the stones in the '827 patent are planar... Moreover the disclosure of the patent clearly indicates that the stone is designed to have only the face (10) of the stone to be the upper face and contrary to the Examiner's contention, it would not be obvious to lay the oblong stone in Scheiwiller patent with the side surface as the top surface.

However, Claim 3 clearly recites "whereby said 2nd molded block can be rotated through 90⁰ and/or 180⁰ about its horizontal longitudinal axis during laying, with a constant block height".

To that affect, the claimed limitation is in the alternative and by Applicant's own admission, the paving stone of Scheiwiller could be rotated through 180⁰ during laying with a constant block height.

Still further, it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish.

In re Mason, 114 USPQ 127, 44 CCPA 937 (1957). Thus the phrase "whereby said 2nd molded block can be rotated through 90 and/or 180 degrees about its horizontal longitudinal axis during laying, with a constant block height" cannot be used to distinguish over the teachings of the cited prior art. Hence, the argument is not persuasive.

The Applicant argues in favor of Claim 4 by stating "Scheiwiller clearly fails to suggest having a tone the shape of that recited in Claim 4.

However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, Claim 4 recites "A set of molded blocks made of concrete comprising a 1st molded block according to claim 1, a 2nd molded block in the form of a one-piece block which is square in plan view and with dimensions of four cubes with the size of said 1st mentioned cube lying beside one another".

To that affect, Scheiwiller '826 discloses the use of cuboidal paving stones, which obviously is square in any view. Further Scheiwiller '826 discloses the paving stone can be used in combination with other stones of different shapes and sizes, in order to form various patterns and rectilinear pathways.

Scheiwiller '764 clearly states "it is clear that the stone may have any other shape, e.g. the configuration of a sector, such as stone 10 in fig. 10 for permitting the stone to be laid down into a circle or to produce stones with greater or shorter lengths". Hence, the argument is not persuasive.

Finally, Applicant argues "New claim 12 is dependent form claim 1 and requires at least 2 of the surfaces of the stone to be flat over the entire area of the faces".


However, Claim 12 is not new, Claim 12 was introduced in the amendment filed 5/3/2002, as paper 11; and was amended in the amendment filed 4/7/2003, paper # 20. To that affect, Scheiwiller '826 discloses planar faces (10, 16, 31) and the bottom face, which is unnumbered. Further Scheiwiller '826 clearly teaches the face (10) is designed as a planar or at most slightly convex surface...and having a rounded off phase (11) between the face (10) and the side faces; as is represented by the short peripheral lines indicated. Hence, it is obvious that planar face (10) with a portion of the rounded off phase (11) is substantially planar over the entire surface area, since rounded off phase is disclosed and illustrated as being a miniscule portion of both the top and side faces.

Art Unit: 3671

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Addie whose telephone number is (703) 305-0135. The examiner can normally be reached on Monday-Friday from 8:00 am to 2:00 pm, 6-8 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-8623.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.



Thomas B. Will
Supervisory Patent Examiner
Group 3600

RWA
4/17/2003